



2FW

PATENT  
Customer No. 22,852  
Attorney Docket No. 3806.0520-01

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
)  
Eric BACQUÉ et al. ) Prior Group Art Unit: 1625  
)  
Application No.: 10/607,220 ) Prior Examiner: D. M. Seaman  
)  
)  
Filed: June 27, 2003 )  
)  
For: HETEROCYCLYLALKYLPIPERIDINE )  
DERIVATIVES, THEIR PREPARATION )  
AND COMPOSITIONS CONTAINING )  
THEM )  
)  
)  
)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

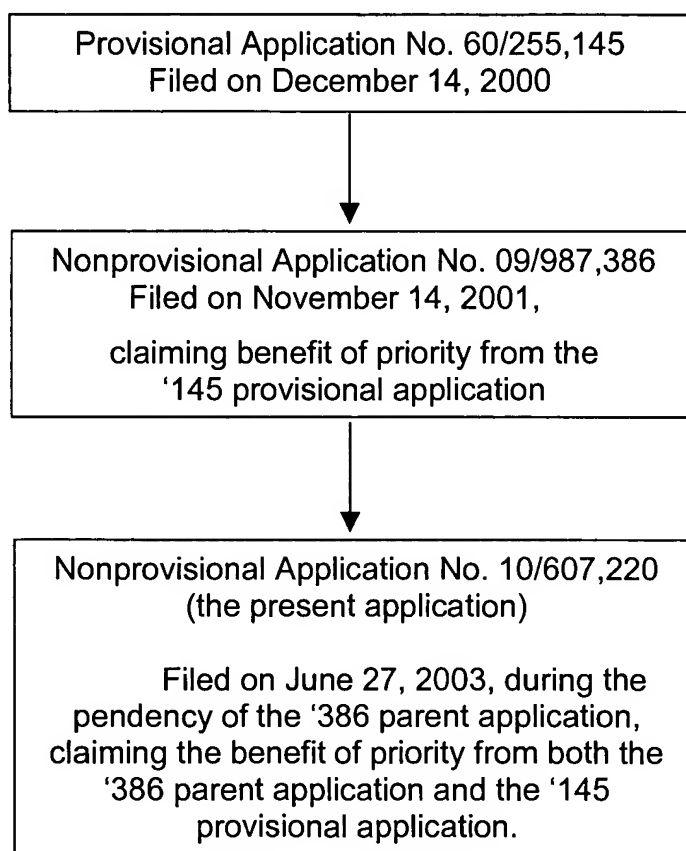
**SECOND REQUEST FOR CORRECTED FILING RECEIPT**

In reply to the Office's response to Applicants' first Request for Corrected Filing Receipt, Applicants provide the following remarks.

Applicants filed a Request for Corrected Filing Receipt on April 12, 2004, requesting the Office's acknowledgement of the present application's claim for domestic priority based on U.S. Provisional Application No. 60/255,145, filed on December 14, 2000 (the '145 provisional application). In the Response to Request for Corrected Filing Receipt mailed April 20, 2004 (enclosed as Exhibit A), the Office declined to comply with Applicants' request because "[t]he application(s) to which priority is claimed were filed over a year prior to the filing date of this application"

In making that statement, the Office seemed to have ignored the presence of an intervening application, which properly claimed priority from the '145 provisional application, and which is the parent of the instant application.

Applicants present the following diagram to represent the relationships between the patent applications at issue in this request.



U.S. Application No. 09/987,386, filed on November 14, 2001, now U.S. Patent No. 6,603, 005, (the '386 parent application) properly claimed priority from the '145 provisional application under 35 U.S.C. § 119(e)(1) as evidenced by the enclosed Filing Receipt (Exhibit B).

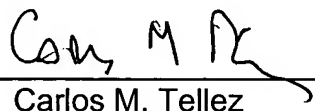
The present application timely and properly claimed the benefit of priority from the '145 provisional application in the transmittal letter that accompanied the present application at the time of filing. See Exhibit C. Because there has been continuity in the chain of applications between the present application and the '145 provisional application, the present application is entitled to the benefit of the filing date of the '145 provisional application.

In light of the foregoing remarks, Applicants respectfully request the issuance of a Corrected Filing Receipt, wherein the present application's claim for domestic priority from the '145 provisional application is acknowledged. The proposed correction is shown in ink on the attached copy of the Filing Receipt (Exhibit D).

Applicants believe there is no fee associated with this request, but the Office is authorized to charge any required fees not enclosed herewith to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Carlos M. Tellez  
Reg. No. 48,638

Dated: May 24, 2004

Enclosures: Exhibits A to D along with a list identifying each exhibits.

### **List of Exhibits**

- A** PTO's Response to Request for Corrected Filing Receipt mailed April 20, 2004.
- B** Filing receipt from the '386 parent application acknowledging the domestic claim for priority from '145 provisional application.
- C** Transmittal letter from the present application properly claiming priority from both the '386 parent application and the '145 provisional application.
- D** Applicants' proposed correction to the Filing Receipt acknowledging the present's application claim for priority from '145 provisional application.



## UNITED STATES PATENT AND TRADEMARK OFFICE

CPE/CTR

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 150  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371(c) DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO./TITLE
10/607,220	06/27/2003	Eric Bacque	3806.0520-01

22852  
 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
 LLP  
 1300 I STREET, NW  
 WASHINGTON, DC 20005

RECEIVED

APR 22 2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
 FARABOW, GARRETT & DUNNER, LLP

CONFIRMATION NO. 5717



\*OC000000012400759\*

Date Mailed: 04/20/2004

## RESPONSE TO REQUEST FOR CORRECTED FILING RECEIPT

## Domestic Continuity and Foreign Priority

In response to your request for a corrected Filing Receipt, the Office is unable to comply with the request because:

- ☐ The priority or continuity claim has not been entered because it was not filed during the required time period. Applicant may wish to consider filing a petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55 or 1.78.
- ☐ Continuity claimed under 35 U.S.C. § 120 cannot be added to the Filing Receipt without the applicant supplying the relationship (continuation, divisional, or continuation-in-part) in an Application Data Sheet or amendment to the first page of the specification.
- ☐ A claim for priority cannot be made based on an application filed after the application making the claim.
- ☐ Domestic benefit and foreign priority claims will not be captured in a provisional application. A provisional application is not entitled to a right of priority or to the benefit of an earlier filing date of any other application. See 35 U.S.C. § 111(b)(7) and 37 CFR 1.53(c)(4).
- ☐ A domestic continuity claim cannot be made to a foreign application and the filing receipt will only list the foreign country, application number, and filing date.
- ☐ Foreign priority will appear on the Filing Receipt in the following order: **Country, Application number, Filing date.**
- ☐ This application is the result of a conversion from a provisional application. Priority based on such application cannot be made since it no longer exists as a provisional application.

RTK

APR 23 2004

OK'd  
 4-22-04  
 JJS

☒ The application(s) to which priority is claimed were filed over a year prior to the filing date of this application. Therefore, the referenced application(s) cannot be claimed as domestic or foreign priority.

☐ To change the benefit claim of a U.S. prior-filed application, applicant must amend the first sentence of the specification (if the benefit claim is referenced in the specification), or provide a supplemental application data sheet (ADS) (if the benefit claim was submitted in an ADS), with the desired benefit claim. Note that once a benefit claim is deleted, applicant will not be able to claim such prior-filed application again, if the above-identified application was filed on or after November 29, 2000.

☐ To change a foreign priority claim, applicant must submit a supplemental oath or declaration (if the priority claim is referenced in the oath or declaration), or a supplemental application data sheet (ADS) (if the priority claim was submitted in an ADS), with the desired priority claim. If a supplemental ADS is submitted, any deletions should be shown with strikeouts. Note that once a priority claim is deleted, applicant will not be able to claim such foreign application again, if the above-identified application was filed on or after November 29, 2000.

*H. Sam*

Customer Service Center  
Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

Application Request: No

Title

Heterocyclalkylpiperidine derivatives, their preparation and compositions containing them

Preliminary Class

546

**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

Prior Application Art Unit: 1625 Prior Application Examiner: D. M. M. Seaman

SIR: This is a request for filing a

☐ Continuation ☐ Continuation-in-Part ☒ Divisional Application under 37 C.F.R. § 1.53(b) of pending prior Application No. 09/987,386 filed November 14, 2001 of Eric BACQUÉ, Jean-Christophe CARRY, Youssef EL-AHMAD, Michel EVERS, Philippe HUBERT, Jean-Luc MALLERON, Serge MIGNANI, Guy PANTEL, Michel TABART, and Fabrice VIVIANI for HETEROCYCLYLALKYLPIPERIDINE DERIVATIVES, THEIR PREPARATION AND COMPOSITIONS CONTAINING THEM.

1. ☒ Enclosed is a complete copy of the prior application including the oath or Declaration and drawings, if any, as originally filed. I hereby verify that the attached papers are a true copy of prior Application No. 09/987,386 as originally filed on November 14, 2001, which is incorporated herein by reference.
2. ☐ Enclosed is a substitute specification under 37 C.F.R. § 1.125.
3. ☐ Enclosed is a Request for Non-Publication of Application and Certification Under 35 U.S.C. § 122(b)(2)(B)(i).
4. ☒ Cancel Claims 1-19.
5. ☒ A Preliminary Amendment is enclosed.
6. ☒ The filing fee is calculated on the basis of the claims existing in the prior application as amended at 4 and 5 above.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com



Basic Application Filing Fee					\$750	\$ \$750.00
	Number of Claims		Basic	Extra Claims		
Total Claims	13	-	20		x \$18	0.00
Independent Claims	5	-	3	2	x \$84	\$168.00
<input type="checkbox"/> Presentation of Multiple Dep. Claim(s)					+\$280	
Subtotal						\$ \$918.00
Reduction by 1/2 if small entity						-
TOTAL APPLICATION FILING FEE						\$ \$918.00

7. ☒ A check in the amount of \$918.00 to cover the filing fee is enclosed.
8. ☒ The Commissioner is hereby authorized to charge any fees which may be required under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment, during the pendency of this application to Deposit Account No. 06-0916.
9. ☒ Amend the specification by inserting before the first line, the following new paragraph:
- This is a divisional of Application No. 09/987,386, filed November 14, 2001, and claims the benefit of U.S. Provisional Application No. 60/255,145, filed December 14, 2000, and French Application No. 00 14738, filed November 15, 2000; all of the foregoing prior applications are incorporated herein by reference.
10. ☐ New acceptable drawings are enclosed.
11. ☒ The prior application is assigned of record to: Aventis Pharma S.A.
12. ☒ Priority of French Application No. 00 14738, filed on November 15, 2000, is claimed under 35 U.S.C. § 119. A certified copy
- ☐ is enclosed or ☒ is on file in the prior Application No. 09/987,386.
13. ☐ Small entity status is appropriate and applies to this application.
14. ☒ The power of attorney in the prior application is to at least one of the following: FINNEGAN, HENDERSON, FARABOW, GARRETT &

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

DUNNER, L.L.P., Douglas B. Henderson, Reg. No. 20,291; Ford F. Farabow, Jr., Reg. No. 20,630; Arthur S. Garrett, Reg. No. 20,338; Donald R. Dunner, Reg. No. 19,073; Brian G. Brunsvold, Reg. No. 22,593; Tipton D. Jennings, IV, Reg. No. 20,645; Jerry D. Voight, Reg. No. 23,020; Laurence R. Hefter, Reg. No. 20,827; Kenneth E. Payne, Reg. No. 23,098; Herbert H. Mintz, Reg. No. 26,691; C. Larry O'Rourke, Reg. No. 26,014; Albert J. Santorelli, Reg. No. 22,610; Michael C. Elmer, Reg. No. 25,857; Richard H. Smith, Reg. No. 20,609; Stephen L. Peterson, Reg. No. 26,325; John M. Romary, Reg. No. 26,331; Bruce C. Zotter, Reg. No. 27,680; Dennis P. O'Reilley, Reg. No. 27,932; Allen M. Sokal, Reg. No. 26,695; Robert D. Bajefsky, Reg. No. 25,387; Richard L. Stroup, Reg. No. 28,478; David W. Hill, Reg. No. 28,220; Thomas L. Irving, Reg. No. 28,619; Charles E. Lipsey, Reg. No. 28,165; Thomas W. Winland, Reg. No. 27,605; Basil J. Lewris, Reg. No. 28,818; Martin I. Fuchs, Reg. No. 28,508; E. Robert Yoches, Reg. No. 30,120; Barry W. Graham, Reg. No. 29,924; Susan Haberman Griffen, Reg. No. 30,907; Richard B. Racine, Reg. No. 30,415; Thomas H. Jenkins, Reg. No. 30,857; Robert E. Converse, Jr., Reg. No. 27,432; Clair X. Mullen, Jr., Reg. No. 20,348; Christopher P. Foley, Reg. No. 31,354; John C. Paul, Reg. No. 30,413; David M. Kelly, Reg. No. 30,953; Kenneth J. Meyers, Reg. No. 25,146; Carol P. Einaudi, Reg. No. 32,220; Walter Y. Boyd, Jr., Reg. No. 31,738; Steven M. Anzalone, Reg. No. 32,095; Jean B. Fordis, Reg. No. 32,984; Roger D. Taylor, Reg. No. 28,992; Barbara C. McCurdy, Reg. No. 32,120; James K. Hammond, Reg. No. 31,964; Richard V. Burgujian, Reg. No. 31,744; J. Michael Jakes, Reg. No. 32,824; Thomas W. Banks, Reg. No. 32,719; Christopher P. Isaac, Reg. No. 32,616; Bryan C. Diner, Reg. No. 32,409; M. Paul Barker, Reg. No. 32,013; Andrew Chanho Sonu, Reg. No. 33,457; David S. Forman, Reg. No. 33,694; Vincent P. Kovalick, Reg. No. 32,867; James W. Edmondson, Reg. No. 33,871; Michael R. McGurk, Reg. No. 32,045; Joann M. Neth, Reg. No. 36,363; Gerson S. Panitch, Reg. No. 33,751; Cheri M. Taylor, Reg. No. 33,216; Charles E. Van Horn, Reg. No. 40,266; Linda A. Wadler, Reg. No. 33,218; Jeffrey A. Berkowitz, Reg. No. 36,743; Michael R. Kelly, Reg. No. 33, 921; James B. Monroe, Reg. No. 33,971; Doris Johnson Hines, Reg. No. 34,629; Lori Ann Johnson, Reg. No. 34,498; R. Bruce Bower, Reg. No. 37,099; John Rissman, Reg. No. 33,764; Therese A. Hendricks, Reg. No. 30,389; Leslie I. Bookoff, Reg. No. 38,084; Michele C. Bosch, Reg. No. 40,524; Michael J. Flibbert, Reg. No. 33,234; Scott A. Herbst, Reg. No. 35,189; Leslie A. McDonell, Reg. No. 34,872; Thalia V. Warnement, Reg. No. 39,064; Ronald A. Bleeker, Reg. No. 27,773; Kathleen A. Daley, Reg. No. 36,116; C. Gregory Gramenopoulos, Reg. No. 36,532; Anthony M.

Gutowski, Reg. No. 38,742; Yitai Hu, Reg. No. 40,653; Lionel M. Lavenue; Reg. No. 46,859; and Christine E. Lehman, Reg. No. 38,535.

15. ☒ The power appears in the original declaration of the prior application.
16. ☐ Since the power does not appear in the original declaration, a copy of the power in the prior application is enclosed.
17. ☒ Please address all correspondence to FINNEGAN, HENDERSON, FARABOW, GARRETT and DUNNER, L.L.P., 1300 I Street, N.W., Washington, D.C. 20005-3315, **Customer Number 22,852**.
18. ☒ Recognize as associate attorney or agent: Jeremy M. Stipkala, Reg. No 44,359; and Carlos M. Tellez, Reg. No. 48,638.

**PETITION FOR EXTENSION.** If any extension of time is necessary for the filing of this application, including any extension in parent Application No.09/987,386, filed November 14, 2001, for the purpose of maintaining copendency between the parent application and this application, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Carol P. Einaudi  
Carol P. Einaudi  
Reg. No. 32,220

Dated: June 27, 2003

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/607,220	06/27/2003	1614	918	3806.0520-01		13	5

CONFIRMATION NO. 5717

22852  
 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
 LLP  
 1300 I STREET, NW  
 WASHINGTON, DC 20005

## FILING RECEIPT



\*OC000000012189134\*

Date Mailed: 03/26/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Eric Bacque, Gif Sur Yvette, FRANCE;  
 Jean-Christophe Carry, Saint Maur Des Fosses, FRANCE;  
 Youssef El-Ahmad, Creteil, FRANCE;  
 Michel Evers, La Queue En Brie, FRANCE;  
 Philippe Hubert, Maisons-Alfort, FRANCE;  
 Jean-Luc Malleron, Marcoussis, FRANCE;  
 Serge Mignani, Chatenay-Malabry, FRANCE;  
 Guy Pantel, La Queue En Brie, FRANCE;  
 Michel Tabart, La Norville, FRANCE;  
 Fabrice Viviani, Louvres, FRANCE;

## Assignment For Published Patent Application

Aventis Pharma S.A.;

RECEIVED

MAR 26 2004

## Domestic Priority data as claimed by applicant

This application is a DIV of 09/987,386 11/14/2001 PAT 6,603,005

This application claims the benefit of priority from  
 Foreign Applications US Provisional Application No. 60/255,145, filed on 14-Dec-2000  
 FRANCE FR 00 14738 11/15/2000

FINNEGAN, HENDERSON,  
 FARABOW, GARRETT & DUNNER, LLP.  
 14-Dec-2000

If Required, Foreign Filing License Granted: 03/24/2004

RTK

Projected Publication Date: 07/01/2004

APR 05 2004

Nht 04-01-04 Rm

Non-Publication Request: No

Early Publication Request: No

Title

Heterocyclalkylpiperidine derivatives, their preparation and compositions containing them

Preliminary Class

514

---

**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).